

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 20, 22, 24, 25, 36, 42, 51, 52 and 54 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The dependent claims recite "consisting of" which is a closed term which does not allow any additional component, but claims recite an open term, "comprises" and "solvent system" which permits additional components. Applicant asserts that said "comprises" defines the subset of the solvent system or the structural constituent, but the examiner disagrees with applicant for following reason: Said "comprises" should be "is" when the subset is further defined. For example, said "comprises" in "the solvent system comprising" would permits other components such as dispersant and thus would improperly broadens scope of "consisting of". Independent claims with "consisting of" should be definite by themselves, but the dependent claims with "comprising" opens a door for possible additional components. Furthermore, the bottom of page 10 teaches that a solvent such as water can contain other components such as a salt, and thus the recited "solvent system" and "comprises" would permit other components contrary to applicant's assertion. The metes and bounds of claims are unclear and confusing and claims are indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20, 24-27, 30-36, 42, 47-49 and 51-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobayashi (US 5,965,319).

Kobayashi teach a composition comprising cresol novolak resin, resol resin, fluoro-surfactant and a mixture of solvents and a coated substrate thereof in examples 13-16 (col. 54). O-cresol based novolak resin is taught at bottom of col. 38 and other solvents such as ethylene glycol monomethyl ether and ethyl lactate are taught at col. 42, lines 24-49. See *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that is disclosed and must not be limited to preferred embodiments or working examples. Said solution inherently lowers the recited apparent viscosity since the same or similar components are used.

As pointed out above, "solvent system" permits other components and thus a minute amount of a compound with formula (I) and IR absorbing agent with said mixture of solvents in said examples 13-16 would fall within scope of the instant solvent system.

Thus, the instant invention lacks novelty.

Claims 18-22, 24-27, 30-36, 41, 42, 47-49, 51-56, 76 and 77 are rejected under 35 U.S.C. 103(a) as obvious over Kobayashi (US 5,965,319) in view of Hattori (US 6,165,676).

The instant invention recites propylene glycol (mono)methyl ether acetate over Kobayashi. However, Hattori teaches a mixture of solvents A and B for novolak polymers at col. 4, lines 11-67. One of the solvent A comprises isopropyl alcohol (2-propanol, line 14) and one of the solvent B comprises propylene glycol monomethylether acetate, (PGMEA, lines 48-49).

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize a mixed solvent of isopropyl alcohol (2-propanol) and propylene glycol monomethylether acetate of Hattori in Kobayashi since Kobayashi teaches the utilization of a mixed solvents and since the instant mixture of solvents for novolak polymer system is well known as taught by Hattori absent showing otherwise.

Claims 18-22, 24, 25, 36, 41, 42, 47-49, 51, 52, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 281602 in view of Hattori (US 6,165,676) and further in view of Miyamoto et al (US 6,808,857).

Rejection is maintained for reason of record with following response.

As pointed out above, "solvent system" permits other components such as the catalyst based on sulfonic acid of FR.

Furthermore, a first part of FR comprising all components (resol, surfactant, novolac with solvents of Hattori and Miyamoto et al) without a catalyst (second part)

would be a *prima facie* obviousness. The examiner doubts that the claim 18 with additional limitation to a solvent system such as "a solvent system consisting of solvents only" alone would overcome the rejection based on the above first part of FR.

Claims 18-21, 24, 25, 36, 41, 42, 47-49, 51, 52, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 281602 in view of Drage (US 5,858,547) and further in view of Miyamoto et al (US 6,808,857).

Rejection is maintained for reason of record with above response.

A receipt of Appendix for resol and novolac is acknowledged and thus a rejection based on Drage as a primary reference is withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Tae H Yoon/
Primary Examiner
Art Unit 1796

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